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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,249	03/17/1999	TAKASHI SHINZAKI	614.1948	3857

21171 7590 02/19/2003

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WASHINGTON, DC 20001

EXAMINER

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/271,249

Applicant(s)

SHINZAKI ET AL.

Examiner

Grigory Gurshman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 68  
2/19/03
- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Correction of the drawings is approved. Drawing changes correct the typographical error and do not present a new matter.

### *Response to Arguments*

2. Referring to the rejections stated in the first office action, applicant points out that the important feature of claimed invention is a "conversion" of original biometric information, whereby the invention renders it possible to prevent the original biometric information from being stolen. Examiner agrees and also points out that this very important feature of the claimed invention is explicitly taught by Kanevsky (U.S. Patent No. 6.092.192). Kanveskiy teaches conversion by the way of encryption performed on the original data in the encryption device (see Fig 3). It is also taught in Priddy (U.S. Patent No. 5.984.366) – see column 7, lines 33 –35.
3. Referring to claims 1-8 and 19-21, applicant argues that according to the instant claims the biometric information is first converted and then the feature information is extracted. Examiner agrees and points out that Kanvesky teaches first encrypting the information and then creating an encrypted print (feature information) - see Fig 2, blocks 200, 202, 204.
4. Referring to claims 9-16 and 22-24, applicant points out that according to the instant claims the converted extracted feature information is compared with registered such information for verification purposes. However, Kanevsky explicitly teaches comparing

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previously stored sample with the contemporaneously provided sample (see column 4, line 15) within the biometric verification system (see column 6, line 5).

5. The claims 17 and 25 are amended. Applicant's amendment reflect "conversion process, selected from a group consisting of expansion, compression, rotation, deformation, affine transformation, morphing, coordinate transformation ...". Applicant's amendment raises the need to apply additional prior art - U.S. Patent No. 5.984.366 to Priddy. Claims 17 and 25 are anticipated by Priddy (see 35 USC 102(e) rejection of the instant claims below).

6. The new claims 27- 30 are added. Examiner states that the instant claims are also anticipated by Kanevsky (see 35 USC 102(e) rejection of claims 27-30 below).

7. In view of the following rejections and response to arguments above, rejections are maintained in view of the prior art applied in the first office action and additional prior art reapplied against amended claims.

### ***Claim Rejections - 35 USC § 102***

8. Claims 1-16, 18-24 and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky (U.S. Patent No. 6.092.192).

9. Referring to the instant claims, Kanevsky discloses a method for repetitive enrollment in a biometric recognition system (see title and abstract).

Referring to claims 1, 9, 14 and 18, Kanevsky teaches the method of extracting, processing and recognizing the biometric information of the user (see abstract and Fig 2). The limitation "measuring means for measuring biometric information" is met by a

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spoken utterance (see column 4, lines 60-65 and Fig 3), which receives the biometric (voice) sample. The limitation "converting means for carrying out a predetermined conversion process" is met by encryption device (see Fig 3).

"Extracting feature information from the converted biometric information" is met by an extractor for extracting a biometric attribute from a user (see column 3, line 40). The limitation "verifying the extracted feature" is met by comparing previously stored sample with the contemporaneously provided sample (see column 4, line 15) and by biometric verification system (see column 6, line 5).

"Information registered in advance" is met by storing biometric attribute in a memory device of a server (see column 3, line 40).

10. Referring to claims 2, 3, 10 and 11, the limitation "personal information related to the individual as the parameters" are met by password and decryption key (see column 8 line 40).

11. Referring to claims 4, 7, 8 and 12, the limitations recited in these claims are met by Fig 1, which shows a network with the client computers where the extraction and encryption takes place and the server where verification takes place. The limitation "enciphering key" is met by the encryption keys (see column 7, line 55-65).

12. Referring to claims 5, 6, 13 -16, 19 - 24, 26- 30, Kanevsky teaches the use of a server memory device(see abstract), which constitutes "computer-readable storage medium", recited in the instant claims. It is inherent to use computer-readable storage medium in the client-server infrastructure on both client and server ends.

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13. Claims 17 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Priddy (U.S. Patent No. 5,984,366).

14. Referring to the instant claims Priddy discloses a system for creating and authenticating self-verifying articles (see abstract). The limitation "converting means for carrying out a predetermined conversion process" is met by computer which includes the necessary encodation (conversion) algorithms (see column 5, lines 28 - 29).

Priddy teaches encoding the biometric data by using at list compression algorithms (see column 7, lines 33 -35). It is inherent to use expansion, rotation, deformation, affine transformation, morphing, coordinate transformation etc. for conversion of digital data.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (703) 306 – 2900. The examiner can normally be reached on 9 AM-5:30 PM.

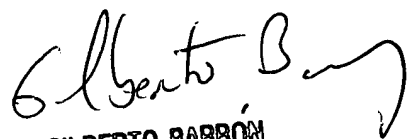
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 receptionist whose telephone number is (703) 305-3900.

Grigory Gurshman  
Examiner  
Art Unit 2132

GG

February 6, 2003

  
GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100